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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/296,582	04/23/1999	JOHN R. PEERY	000952066	8609

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EXAMINER
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MAYNARD, JENNIFER J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/296,582

Applicant(s)

PEERY, JOHN R.

Examiner

Jennifer J Maynard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 21-25 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 7-17 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Utterberg (US 5,536,259 A).

Utterberg discloses a hypodermic cannula comprising a tube having a sharp end formed by a first cut surface (12) equivalent to applicant's trailing edge defining an acute angle of approximately 20 degrees, when measured in view of Figure 2, is actually 18 degrees, to the longitudinal axis (14) of the tube and forming a generally oval tube edge, and a second cut surface (20) equivalent to applicant's leading edge defining a right hand forward portion of the oval tube edge (16) and being made at a different acute angle to the axis (14), when measured in view of Figure 2, is actually 22 degrees. The cutting point and all the forward cutting edges are spaced inwardly at an angle of approximately 14.5 degrees from the cannula outer wall thus exhibiting extreme incision sharpness for maximized patient comfort and also protection from hematomas, see Column 1, lines 51-57.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmon (US 5,772,671 A) in view of Harris (US 421,072 A).

Harmon discloses a device for implanting articles under the skin comprising a cannula (50, 60) with a penetrating distal end, a retaining means (58) housed entirely within the cannula for holding an implant within the cannula prior to administration thereof, and a push rod (11) for forceably ejecting the implant under the skin of an animal.

Harmon discloses the invention as claimed with the exception of the retaining means being in the form of a leaf spring and the obturator having a tapered distal end.

Harris discloses a surgical applicator comprising jaws (f) in the form of three leaf springs near the distal end of the cannula (a, a") for the purpose of retaining a pellet, pill, capsule, suppositories or the like within the cannula (a, a") until discharged by the plunger rod (b).

It would have been obvious to one having ordinary skill in the art to have modified the cannula of Harmon with the leaf springs of Harris in the alternative to the friction ribs of Harmon as they are considered to be functional equivalents known in the art.

With respect to Claim 2, the Examiner considers the language to be broad enough to encompass a leaf-spring formed by cutting a plate. Since the process of manufacture is not given patentable weight in apparatus claims and the prior art need only have the final structure, the

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Examiner considers that the leaf-spring of Harris could have been made by cutting a plate into strips forming three leaf-springs.

With respect to Claim 7, it would have been obvious to have provided Harris' obturator (b) with a tapered distal end so as to facilitate smooth entry of the obturator into the proximal end of the cannula/tube (a). Harris' obturator is threaded from the proximal end of the cannula/tube to the distal end thereof at which point the flat distal end of the obturator engages the leaf springs (f) so as to cause distal movement of the medicament pellet. Harris' flat end could undesirably allow for premature delivery of the medicament pellet given that the sharply defined edges of the obturator's flat end would cause outward movement of the leaf springs (f) prior to any engagement of the obturator's tip with the medicament pellet. By tapering the distal end of the obturator it would enable more accurate timing of the delivery by ensuring that a portion of the obturator's tip engages a proximal end of the medicament pellet prior to the release thereof.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harmon (US 5,772,671 A) in view of Harris (US 421,072 A), and further in view of Utterberg (US 5,536,259 A).

Harmon in view of Harris discloses the invention as claimed with the exception of the cannula having two cutting surfaces.

Utterberg discloses a cannula having two cutting surfaces.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the cannula taught by Harmon in view of Harris with the cutting tip of Utterberg so as to provide the cannula with a cutting point and forward cutting

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edges which are spaced inwardly from the cannula outer wall thereby allowing the cannula to exhibit extreme incision sharpness for maximized patient comfort and also to protect against the development of hematomas.

***Allowable Subject Matter***

Claims 4-6 and 21-25 are allowed.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to Claims 1, 2, 7, and 8 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicant's assertion that Utterberg (US 5,536,259 A) fails to disclose "a first angle of the leading edge is larger than the second angle of the trailing edge", the Examiner directs Applicant to Figure 2 of Utterberg (US 5,536,259 A) which clearly shows a first angle of about 22 degrees and a second angle of about 18 degrees, which sets forth a larger first angle than the second angle. The disclosure of a 14.5 degree angle within Utterberg's disclosure is with respect to the angle at which the beveled cut of the leading edge is made.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer J Maynard whose telephone number is 703.305.1356. The examiner can normally be reached on 10:30 am-8:30 pm; 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703.308.3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9302 for regular communications and 703.872.9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

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J Maynard

February 25, 2002

*J Maynard*

*Glenn K. Dawson*  
GLENN K. DAWSON  
PRIMARY EXAMINER